

Appln No.: 10/029,667
Filing Date: 10/22/2001
Attorney Docket No. 104348

Applicant(s): CHASE, et al.
Examiner: CHANKONG, DOHM
Group Art Unit: 2152

Remarks

This communication is responsive to the Final Office Action of September 24, 2008. Reexamination and reconsideration of the claims is respectfully requested.

Summary of The Office Action

Claims 43, 48-50 and 52-54 were rejected under 35 USC 103(a) as being unpatentable over Schmid et al, U.S. Patent No. 6,438,578 (Schmid), in view of Thompson et al, U.S. Patent Publication No. 2002/0077900 (Thompson).

Claims 44-47 were rejected under 35 USC 103 (a) as being unpatentable over Schmid and Thompson, in view of Bandera et al, U.S. Patent 6,332,127 (Bandera).

Claim 51 was rejected under 35 USC 103(a) as being unpatentable over Schmid and Thompson in view of Subramaniam.

Response

The Claims Patentably Distinguish Over the References of Record

35 U.S.C. §103

To establish a prima facie case of 35 U.S.C. §103 obviousness, basic criteria must be met. The prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.(A) Section 2131 of the MPEP recites how "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). This same standard applies to 103 rejections as evidenced by Section 2143(A) of the MPEP, which reads: "The rationale to support a conclusion that the claim would have been obvious is that **all the claimed elements** were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions".

When establishing a prima facie case of obviousness the Office must clearly articulate the reason(s) the claimed invention would have been obvious. MPEP 2142 recites that:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This requirement is intended to prevent unacceptable "hindsight reconstruction" where Applicant's invention is recreated from references using the Application as a blueprint.

Here, the criteria for establishing a prima facie case of obviousness are not satisfied since the combination of references does not teach or suggest all the claim limitations. None of the references, alone and/or in combination, teach maintaining access to a plurality of secondary content addresses. Thus, it follows that the references do not teach the second content addresses identifying secondary content. Additionally, concerning claim 49, none of the references teach including addresses of both the initial content source and at least one secondary content source in redirection information that is provided back to a requesting client. Finally, concerning claim 50, none of the references teach providing a command that causes initial content to be retrieved concurrently with secondary content. Thus, none of the claims are obvious for at least these reasons.

Independent Claims 43 and 54

These claims both recite “maintaining access to a plurality of secondary content addresses.” The Office Action asserts, on page 5, that Schmid teaches this in column 6, lines 41-56. This is incorrect.

The Advisory Action attempts to rebut this plain fact by relying on “implications” and things that are “inherently” provided. Applicant explains herein what actually appears in the reference, and how the actual words in the reference are directly opposite to the purported “implications” and “inherent” items.

The Advisory Action asserts that Schmid discloses that supplemental information is stored at a remote source. The Advisory Action therefore concludes that there is a “clear implication” that (1) secondary content addresses are stored and (2) that the client maintains access to them. These are both incorrect. The system in Schmid could acquire the supplemental information using a push model that is initiated by, for example, an interrupt, a broadcast message that includes no secondary content addresses, and so on. Thus, the “clear implication” asserted by the Advisory Action is neither clear, nor even implied.

The Advisory Action also asserts that since Schmid requests supplemental information, it must “inherently” include some form of identifier that identifies the content. This is incorrect and irrelevant.

The request for supplemental information could be a “tell me what you know” or “give me what you have” request that includes no identifier. This understanding of Schmid is supported by what is **actually written** in Schmid, rather than what is “inherently” included. Consider, for example, the second sentence of the portion of Schmid that purportedly “inherently” teaches the claimed addresses. The sentence reads “the supplemental information source 16 is a collection of information, that although **not specifically requested** by the network client 12...” If there is no specific request, how can the reference possibly disclose, even inherently, an “identifier” of specifically requested information? Quite simply, it can't. By

considering what the reference actually says, instead of what it purportedly "inherently" says, the reference is proven to not provide a prima facie case for obviousness.

The following table proves that this cited portion does not teach maintaining a plurality of secondary content addresses.

| Sentence | Teaches Maintaining Access To Plurality of Secondary Content Addresses? |
|--|---|
| The format and request instructions sent to the network client 122 also cause the network client 12 to request supplemental information from a supplemental information source 16. | No. |
| In a preferred embodiment of the invention, the supplemental information source 16 is a collection of information that, although not specifically requested by the network client 12, would likely be of interest to the network client 12. | No. |
| The supplemental information may include advertisements of businesses that offer goods or services related in some way to the requested information. | No. |
| The supplemental information may also include news, weather reports, and other information that may not be directly related to the requested information. | No. |
| The supplemental information that is requested by the network client 12 can be determined according to one or more selection and prioritization methods. | No. |

Thus, the references do not teach maintaining access to a plurality of secondary content addresses. It is clear why Schmid does not store these addresses. Just a few lines below the cited portion of Schmid the reason is found. Concerning the supplemental information source 16, the reference reads: "in the preferred embodiment it is local." Since the supplemental information source is local, there is no need to store **any** secondary content address, let alone the claimed **plurality** of secondary content addresses.

Even if a secondary content address is found in the reference by "official notice", by "implication", or by other means that do not rely on the reference itself, that address cannot possibly make obvious the claimed "secondary content address identifying secondary content." As actually described in Schmid, not as divined to be inherent or implied, in the preferred embodiment the "supplemental information" is neither "specifically requested" nor even "directly related to the requested information". Since it is neither specifically requested nor even directly related to the requested information, there is no motivation to even add an identifier and address to the reference.

Thus, for at least these reasons, none of the independent claims are obvious. Therefore, all the independent claims are in condition for allowance. Accordingly, all the dependent claims are similarly in condition for allowance.

Claim 49

This claim includes additional elements and limitations describing how an address of the initial content source and an address of at least one secondary content source are provided in the redirection codes provided "to the requesting device." As described above, the references do not describe maintaining even a single secondary content address, therefore it is impossible for the references to teach providing the missing address back to the requesting device.

Furthermore, even if an address is located in one of the references, the references do not teach providing the address back to the requesting device. To the extent that any address is provided to any entity, the address is provided to the content source, not to the requesting client. Thus, for this additional reason, this claim is not obvious and is in condition for allowance.

Claim 50

This claim includes additional elements and limitations describing how a command is passed to the requesting device, via the redirection information, to **concurrently retrieve** the initial content **during the retrieval** of the secondary content. The Office Action asserts that Schmid as modified by Thompson teaches this in column 6, lines 8-28 and lines 41-44. The Office Action has overlooked the word “concurrently” in the claim.

The Advisory Action has taken the impermissible liberty of finding a “whereby” clause in a claim that includes no such clause. Applicant has, however, amended this claim to make even more clear that the command sent to the requesting device is to control the requesting device to retrieve initial content and second content concurrently.

Schmid acquires initial content and supplemental content in distinct, serial steps. Similarly, Thompson also acquires content in distinct, serial steps. The combination of Schmid and Thompson therefore must only acquire content in distinct, serial steps. If the content were acquired concurrently, then neither Schmid nor Thompson could operate as described. Therefore, this claim is not obvious over this combination of references for at least two reasons. First, the references do not teach each and every element of the claim. Second, any proposed modification to the references would require the references to change their principle of operation.

The Office Action is just wrong when it asserts that Schmid concurrently sends out retrieval requests for both requested and supplemental information.

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Sending out requests in serial, where one does not proceed until the other has responded, is the exact opposite of "concurrently".

A proposed modification cannot change the principle of operation of a reference. MPEP 2143.01 states that if the proposed combination of the prior art would change the principal operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.

Thus, for at least these two reasons, this claim is not obvious over the references and any proposed modification of these references.

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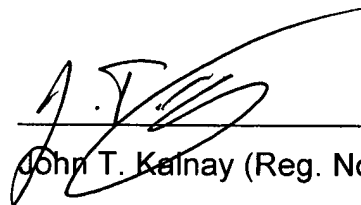
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Conclusion

For the reasons set forth above, the claims are now in condition for allowance. An early allowance of the claims is earnestly solicited.

Respectfully submitted,

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John T. Kalnay (Reg. No. 46,816)

KRAGULJAC & KALNAY, LLC
Summit One, Suite 510
4700 Rockside Road.
Independence, OH 44131

Telephone: 216.308.3245
Facsimile: 216.503.5401